

Remarks/Arguments

The Applicants have carefully reviewed the Office Action mailed July 8, 2003, and this paper is responsive thereto.

In the specification, the paragraph beginning at page 10, line 2 has been amended to address the Examiner's objection.

Claims 1-41 remain in this application. Claims 18, 34, 36, and 37 have been withdrawn. Claims 18 and 34 have been withdrawn as the result of an earlier restriction requirement. Claims 36 and 37 have been withdrawn as being drawn to a nonelected group, there being no allowable generic or linking claim.

In the Examiner's action, claims 1-17, 19-33, 35, and 38-41 were rejected under 35 U.S.C. § 103(a). The Examiner also objected to the disclosure because of an informality. By this response, the Applicants have amended claims 1, 16, 32, and 38. Additionally by this response, the Applicants have added claims 42-49. No new matter has been introduced into the application. The claims as amended and added are believed to be in allowable condition.

The following remarks traverse the remaining grounds for rejection. The Applicants respectfully request reconsideration of the application, withdrawal of the rejections, and allowance of all pending claims.

Objection to the Specification

The Examiner objected to the disclosure because of an informality. The Applicants have amended the specification in response to this objection so that page 10 now refers to "FIGURE 5A and FIGURE 5B" rather than only "FIGURE 5." The Applicants believe that the specification is in allowable condition.

Rejection Under 35 U.S.C. § 103(a)

Claims 1-17, 19-33, 35 and 38-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dall et al. in U.S. Patent No. 5,665,089 in view of Judet et al. in U.S. Patent No. 5,591,168. The Applicants traverse the rejection in view of the above amendments and the following remarks.

There are three requirements to establish a *prima facie* case of obviousness:

- (1) "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings";
- (2) "there must be a reasonable expectation of success"; and
- (3) "the prior art reference (or references when combined) must teach or suggest all the claim limitations."

MPEP § 706.02(j). Here, no *prima facie* case of obviousness has been established. The references do not teach or suggest all the claim limitations, and there is no evidence of any suggestion or motivation to modify the prior art reference cited or combine the reference teachings.

A. The Cited References Fail to Teach or Suggest All the Claim Limitations

Neither Dall et al. alone nor the combination of Dall et al. and Judet et al. teach or suggest all the claim limitations of the instant application as amended. Neither Dall et al. nor Judet et al. disclose the claw claimed in the instant application as amended. The Examiner correctly notes that the Dall et al. reference fails to disclose a claw having at least one extension or hook. Independent claims 1, 16, 32, and 38 have been amended to clarify the meaning of the term "extension or hook." These amendments clarify that the claw of the instant invention has at least one extension or hook that has at least one tooth that is adapted to impact into a bone, such as the bone of the greater trochanter, such that the claw can fixate the greater trochanter in position and is further stabilized by the cables. Neither Dall et al. nor Judet et al. discloses such a claw. Thus, the combination of Dall et al. and Judet et al. does not disclose all the limitations of independent claims 1, 16, 32, and 38 of the instant application. The dependent claims, which depend from and further limit the amended independent claims 1, 16, 32, and 38, are patentably distinct from the combination of Dall et al. and Judet et al. for at least the same reasons. Claims 2-11 depend, directly or indirectly, from independent claim 1. Claims 17 and 19-27 depend, directly or indirectly, from independent claim 16. Claims 33 and 35 depend directly from independent claim 32. Claims 39-41 depend, directly or indirectly, from independent claim 38. Thus, the combination of Dall et al. and Judet et al. does not teach or suggest all the limitations of claims 1-17, 19-33, 35 and 38-41.

Additionally, Dall et al. does not disclose a bone screw slot that is a compression-type slot, as claimed in claims 6 and 23 of the instant application. A compression-type slot is shaped such that as the bone screws are tightened, the screws will be biased in the slot towards the

fracture line. The result is that the fracture is compressed and can best promote healing. The Dall et al. reference does not disclose such a bone screw slot that is a compression-type slot.

Also, as the Examiner correctly noted, the Dall et al. reference fails to disclose the following elements:

- at least one cable screw slot along the connector extending from the lateral side to the cable aperture;
- at least one cable screw each engageable with the respective cable screw slot and capable of crimping within the cable aperture;
- a driver slot along the lateral side of the superior end; and
- a driver engageable with the driver slot.

Thus, the combination of the Dall et al. and Judet et al. references fails to teach or suggest at least six limitations of claims 1-17, 19-33, 35 and 38-41 of the instant application as amended. Because the prior art fails to disclose, teach, or suggest these limitations, the present invention is nonobvious over Dall et al. in view of Judet et al.

B. There Is No Evidence of Any Motivation to Modify or Combine the References

Importantly, there is no evidence of any suggestion or motivation to modify or combine the Dall et al. and Judet et al. references to achieve the invention claimed in the instant application. The Office Action did not state any suggestion or motivation to combine the teachings of the Dall et al. and Judet et al. references to achieve the present invention. In fact, the combination of Dall et al. and Judet et al. would not successfully achieve the result of an embodiment of the present invention. New claims 42-45 have been added to clarify that the present invention is adapted for use in the presence of an artificial hip implant. Figure 3 and

Figure 5 of Judet et al. shows that the superior end of the device is screwed into the head of the femur. However, the present invention may be used with an artificial hip implant. Having a hip implant present would make it impossible for the device of Judet et al. to screw into the head of the femur because it has been replaced by the metal implant. Additionally, new claims 46-49 have been added to clarify that the present invention may be used to simultaneously repair periprosthetic fractures of the femur, as well as fractures of the greater trochanter. Neither Dall et al. nor Judet et al. teaches the repair of both these types of fractures at the same time.

With respect to the Dall et al. reference, the Examiner stated that:

Dall et al. also teach to crimp the cable, in column 4. Therefore, the crimping method of Dall et al. can be considered an equivalent method for securing the cables. Therefore, to arrange the crimping in the claimed configuration or any other operable fashion for the purpose of securing the cables would have been obvious to one with ordinary skill in the art.

The Applicants do not agree that the crimping method of Dall et al. is equivalent to the way an embodiment of the instant invention secures the cables. Dall et al. teach that to secure the cables, "[e]ach loop of cable is pulled tight and then locked in place by crimping a respective bridge 42, in a generally conventional way." In contrast, an embodiment of the present invention crimps a cable by winding a cable screw 365 into a cable screw slot 370 to affect the size of the cable aperture 360. The crimping contemplated by an embodiment of the instant invention may be easily seen in Figure 3 of U.S. Patent No. 5,415,658 ("Kilpela et al."), which is incorporated by reference into the instant application. The crimping method of Dall et al. is not an equivalent method for securing the cables to that of an embodiment of the instant invention. Thus, it would not have been obvious to one of ordinary skill in the art to arrange the crimping as in the claimed configuration. Moreover, there is no evidence that it would have been obvious to one of ordinary

skill in the art to arrange the crimping in any other operable fashion for the purpose of securing the cables.

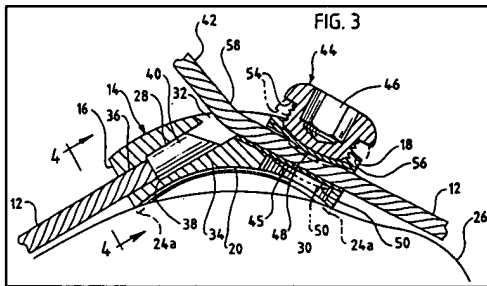


Fig. 3 of Kilpela et al. showing threaded screw 44 in hole 45 to crimp cable 12.

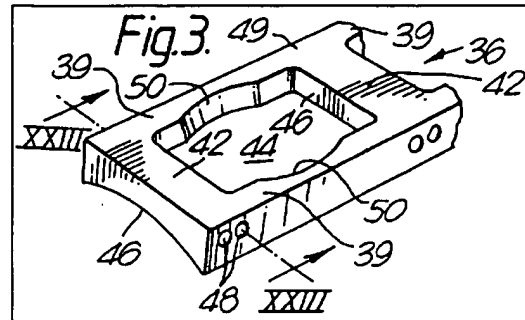


Fig. 3 of Dall et al. showing bridge 42 which is crimped to secure cable passing through holes 48.

Furthermore, even if the crimping method of Dall et al. were equivalent to the way an embodiment of the instant invention secures the cables, there is no evidence that this equivalence is recognized in the prior art. “[T]o rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant’s disclosure or the mere fact that the components at issue are functional or mechanical equivalents.” MPEP § 2144.06. Thus, even if the crimping disclosed by Dall et al. were equivalent to the way in which an embodiment of the present invention secures the cables, this alleged equivalence alone is not sufficient to establish a *prima facie* case of obviousness. See *In re Scott*, 323 F.2d 1016, 1019, 139 U.S.P.Q. 297, 299 (C.C.P.A. 1963) (“Expedients which are functionally equivalent to each other are not necessarily obvious *in view of* one another.”), cited in MPEP § 2144.06. There is no evidence that this alleged equivalence is recognized in the prior art. Therefore, a *prima facie* case of obviousness has not been established.

The Examiner also stated that “it would also be obvious to one with ordinary skill in the art to further provide a driver slot along the lateral side of the superior end and a driver

engageable with the driver slot.” Claims 14, 30, and 32 require a driver slot, and claims 15 and 31 require a driver engageable with the driver slot. However, there is no evidence that one of ordinary skill in the art would be motivated to modify the invention of Dall et al. by adding such a driver slot and a driver engageable with the driver slot. Indeed, Dall et al. make no reference whatsoever to driver slots or drivers, nor do they suggest in any way that it would be desirable to add such features. Absent a suggestion to modify or combine the Dall et al. to arrive at the claimed invention, or to combine the Dall et al. and Judet et al. references to achieve the claimed invention, claims 1-17, 19-33, 35 and 38-41 are nonobvious.

For these and other reasons, the Applicants respectfully request withdrawal of this ground for rejection.

Conclusion

All rejections having been addressed, the Applicants respectfully submit that the instant application is in condition for allowance, and respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: December 8, 2003

By: _____



Binal J. Patel
Reg. No. 42,065

10 S. Wacker Dr., Suite 3000
Chicago, IL 60606-7407
Tel: (312) 463-5000
Fax: (312) 463-5001